

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the response to amendment filed February 13, 2008. Claim 5 was amended and claims 1 and 3-4 were cancelled rendering claims 5 and 7 pending.

### ***New Matter - 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 5 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase, 'wherein only one of said opaque sheets is visible at any point in time' is not supported by the specification.

### ***Claim Rejections – 35 USC 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1794

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the phrase, "wherein only one of said opaque sheets is visible at any point in time" is indefinite. It is unclear at which angle the opaque sheets are being seen from, whether it is from the top, the front, the back or side views. It is also unclear how only one opaque sheet is visible when the sheets are being inserted in the signage apparatus, as more than one sheet will be visible from a top or side view, as the sheets are being inserted in the signage apparatus.

### ***Claim Rejections – 35 USC § 103(a)***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suen (U.S. 6,487,802) in view of Mirza (U.S. 6,347,471).

Suen discloses a multilayered signage apparatus wherein the material displayed may be easily replaced comprising a frame, a clear plastic protective lens, a removable transparency (cover sheet) having graphics and messages and a back drop, which can

Art Unit: 1794

be seen through the transparency (column 1, lines 21-24 and column 2, lines 6-16, 28-39). Suen does not explicitly teach one or more opaque sheet(s) having a graphic image.

Mirza teaches a multi-layered signage apparatus wherein the material displayed may be easily replaced comprising a message holder (frame) having a front (plastic film) and back panel used to display one or more replaceable signs or messages (opaque sheets) including instructions, notes, bulletins and other documents (column 1, lines 12-64 and column 2, lines 11-30) which having printed images on one or both sides (column 3, lines 48-50) which conventionally have graphics or alphanumeric information. The reference teaches a sign or message can be viewed from the front panel (column 5, lines 52-62). Mirza further teaches the signs are removable sheets having additional (different) signs or viewable items 15(c) between the two signs (column 4, lines 60-67 and Figures 5-6). Additional messages appears to be different graphic images.

Suen and Mirza are both related to multilayered signage apparatuses. It would have been obvious to one of ordinary skill in the art to use one or more opaque sheets in between the cover sheet and frame, as taught in Mirza, in the signage apparatus of Suen, to store additional signs or messages (column 4, lines 60-61) and to give an improved layered effect to the sign, where the removable transparency (cover sheet) having graphics and messages of Suen along with the information on one of the opaque sheets of Mirza can be viewed by a single viewer looking at said sign through the removable cover sheet, since the plastic protective lens is clear and the removable

transparency of Suen is transparent. Mirza shows the opaque sheets have similar dimensions, which when viewing through the removable cover sheet, only one of the opaque sheets will be viewable (column 4, lines 56-67). Because the combination of Suen and Mirza discloses the same multilayered signage apparatus having the same function as claimed, it would have been expected for the plastic lens to be non-glare.

### ***Response to Arguments***

8. Applicant's arguments regarding the rejection made under 35 U.S.C. 103(a) as being unpatentable over Suen (U.S. 6,487,802) in view of Mirza (U.S. 6,347,471) have been considered but are unpersuasive. Applicant argues the back drop of Suen contains no graphic display or alphanumeric information and in any given point in time, a viewer looking through the cover sheet of the signage apparatus views the alphanumeric information on the cover sheet along with a graphic image on one of the opaque sheets carried behind the cover sheet. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Although Suen does not explicitly teach one or more opaque sheet(s) having a graphic image, Mirza teaches a multi-layered signage apparatus wherein the material displayed may be easily replaced comprising a message holder (frame) having a front (plastic film) and back panel used to display one or more replaceable signs or messages (opaque sheets) including instructions, notes,

Art Unit: 1794

bulletins and other documents (column 1, lines 12-64 and column 2, lines 11-30) which having printed images on one or both sides (column 3, lines 48-50) which conventionally have graphics or alphanumeric information. It would have been obvious to one of ordinary skill in the art to use one or more opaque sheets in between the cover sheet and frame, as taught in Mirza, in the signage apparatus of Suen, to store additional signs or messages (column 4, lines 60-61) and to give an improved layered effect to the sign, where the removable transparency (cover sheet) having graphics and messages of Suen along with the information on one of the opaque sheets of Mirza can be viewed by a single viewer looking at said sign through the removable cover sheet, since the plastic protective lens is clear and the removable transparency of Suen is transparent. Mirza shows the opaque sheets have similar dimensions, which when viewing through the removable cover sheet, only one of the opaque sheets will be viewable (column 4, lines 56-67).

Applicant argues Mirza only teaches the use of two displayed materials that may be viewed from opposite sides. Mirza teaches a multi-layered signage apparatus wherein the material displayed may be easily replaced comprising a message holder (frame) having a front (plastic film) and back panel used to display one or more replaceable signs or messages (opaque sheets) including instructions, notes, bulletins and other documents (column 1, lines 12-64 and column 2, lines 11-30) which having printed images on one or both sides (column 3, lines 48-50) which conventionally have graphics or alphanumeric information. Mirza further teaches the signs are removable sheets having additional (different) signs or viewable items 15(c) between the two signs

(column 4, lines 60-67 and Figures 5-6). Additional messages appears to be different graphic images.

In response to applicant's argument that Mirza does not teach two different layers of material having images which are both viewable simultaneously from the front of the sign, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The removable transparency (cover sheet) having graphics and messages of Suen along with the information on one of the opaque sheets of Mirza can be viewed by a single viewer looking at said sign through the removable cover sheet, since the plastic protective lens is clear and the removable transparency of Suen is transparent. Applicant argues the cover sheet and plastic protective lens of Suen does not display any alphanumeric information. The Examiner respectfully disagrees as Suen discloses the transparency is printed with graphics and messages as in column 2, lines 5-15.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 1794

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on 571-272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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